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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,881	07/23/1999	RANDY HENRY	HE01-003	4792

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
3711	10

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,881

Applicant(s)

HENRY, RANDY

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 1 March 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/360,881 is acceptable and a RCE has been established. An action on the RCE follows.

Specification

2. The argument with respect to the specification is agreed with and the objection to the specification as failing to provide antecedent basis for the claimed new subsection matter under 37 CFR 1.75(d)(1) and MPEP article 608.01 (o) is removed.

Claim Rejections - 35 USC § 112

3. The arguments with respect to the rejections under 35 U.S.C. 112, first and second paragraph are agreed with and the rejections are removed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-5, 8, 10-13, 15-16, 20 and 22-23 are rejected under 35

U.S.C. 102(b) as being anticipated by Ezaki.

Ezaki discloses a set of clubs comprising a plurality of adjacently sequenced clubs (Table), a first club (#7, Table) having a length of .79 inches longer than a second adjacent club (#8, Table) in a set, a third club (#11, Table) having a club length which is less than .6 inches longer than a fourth adjacent golf club (#12, Table) in the set, a second club (#8, Table) having a length which is greater than .72 inches in the form of .79 inches longer than a fifth club (#9, Table) in a set, a second golf club (#8, Table) having a lie angle of at least about .6 degrees less than a fifth golf club (#9, Table), a first, second and fifth clubs being respectively sequentially adjacent to one another (Table); a first club (#9, Table) having a length of .79 inches longer than a second adjacent club (#10, Table) in a set with a first golf club (#9, Table) having a head weight of at least about 9 grams in the form of 11 grams less than the second adjacent golf club (#10, Table), a first golf club (#9, Table) having a lie angle at least .6 degrees less than the second adjacent golf club (#10, Table); a first club (#8, Table) having a length of .79 inches longer than a second adjacent club (#9, Table) in a set with a second club (#9, Table) having a length which is greater than .72 inches in the form of .79 inches longer than a fifth club (#10, Table) in a set, a second golf club (#9, Table) having a lie angle of at least about .6 degrees less than a fifth golf club (#10, Table), a second golf

club (#9, Table) having a head weight of at least about 9 grams in the form of 11 grams less than the fifth adjacent golf club (#10, Table); a plurality of alternating sequential adjacent clubs (#6, #8, #10, and #12, Table) where a first club (#6, Table) has a length at least 1.2 inches longer than a second alternating sequential adjacent club (#8, Table), a third club (#10, Table) having a length which is less than 1.2 inches longer than a fourth adjacent club (#12, Table in Col. 4, Embodiment 2) in a set, and a first club (#6, Table) head weight being at least 16 grams less than a second alternating club (#8, Table).

6. Claims 1-4, 15-17 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Teramoto (5,121,918).

Teramoto discloses a set of clubs comprising a plurality of adjacently sequenced clubs (Table in Col. 4, Embodiment 2), a first club (#3, Table in Col. 4, Embodiment 2) having a length of .75 inches longer than a second adjacent club (#4, Table in Col. 4, Embodiment 2) in a set, a third club (#6, Table in Col. 4, Embodiment 2) having a club length which is less than .6 inches longer than a fourth adjacent golf club (#7, Table in Col. 4, Embodiment 2) in the set, a second club (#4, Table in Col. 4, Embodiment 2) having a length which is greater than .72 inches in the form of .75 inches longer than a fifth club (#5, Table in Col. 4, Embodiment 2) in a set, a first, second and fifth clubs being respectively sequentially adjacent to one another (Table in Col. 4, Embodiment 2), a plurality of alternating sequential adjacent clubs (#1, #3, #5, #7, and #9, Table in Col. 4, Embodiment 2) where a first club (#3, Table in Col. 4, Embodiment 2) has a length at

least 1.2 inches longer than a second alternating sequential adjacent club (#5, Table in Col. 4, Embodiment 2), a third club (#9, Table in Col. 4, Embodiment 2) having a length which is less than 1.2 inches longer than a fourth adjacent club (#7, Table in Col. 4, Embodiment 2) in a set, and a first club (#3, Table in Col. 4, Embodiment 2) having a length of 1.5 inches longer than a second alternating adjacent club (#5, Table in Col. 4, Embodiment 2) in a set.

7. Claims 1-2, 5-7, 15-16, 18, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kajita.

Kajita discloses a set of clubs comprising a plurality of adjacently sequenced clubs (Fig. 3), a first club (#5-Iron, Fig. 3) having a length of at least about .6 inches in the form of .59 inches (15 mm) longer (Col. 3, Lns. 35-40) than a second adjacent club (#6-Iron, Fig. 3) in a set, a third club (#7-Iron, Table in Col. 4, Embodiment 2) having a club length which is less than .6 inches in the form of .59 inches (15 mm) longer (Col. 3, Lns. 35-40) than a fourth adjacent golf club (#7-Iron, Table in Col. 4, Embodiment 2) in the set, a first club (#5-Iron, Fig. 3) having a lie angle about .75 degrees less (Col. 3, Lns. 35-39) than the second adjacent golf club (#6-Iron, Fig. 3) in the set, a set of 12 clubs (Col. 3, Lns. 30-34), a plurality of alternating sequential adjacent clubs (#3, #5, #7, and #9-Irons, Fig. 3) where a first club (#3-Iron) has a length at least about 1.2 inches in the form of 1.18 inches (30 mm) longer (Col. 3, Lns. 30-34) than a second alternating sequential adjacent club (#5-Iron, Fig. 3), a third club (#9-Iron) having a length which is less than 1.2 inches longer in the form of 1.18 inches (30 mm) (Col. 3,

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Lns. 30-34) than a fourth adjacent club (# 7-Iron) in a set, a first club (#3-Iron, Fig. 3) having a lie between about 1.2-2 degrees less (Col. 3, Lns. 33-34, 38-39) than the second alternating sequential adjacent golf club (#5-Iron) in the set, and a set of 6 clubs (Col. 3, Lns. 30-34).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-9, 18-19, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto in view of Kajita.

Teramoto lacks a first club (#3) having a lie angle at least about .75 degrees less than a second club (#4), a second club (#4) having a lie angle at least about .75 degrees less than a fifth club (#5), at least 12 clubs in a set, and a club in a set having a lie angle of about 1.5 degrees less than the second alternating sequential adjacent club in a set.

Kajita discloses a first club (#4-Iron) having a lie angle about .75 degrees less (Col. 3, Lns. 35-39) than the second adjacent golf club (#5-Iron) in the set, at least 12 golf clubs in a set (Fig. 3), and a club in a set having a lie angle of about 1.5 degrees less than the second alternating sequential adjacent club in a set (Col. 3, Lns. 30-39).

In view of the patent of Kajita it would have been obvious to modify the set of clubs of Teramoto to have a first club (#3) having a lie angle at least about .75 degrees less than a second club (#4), a second club (#4) having a lie angle at least about .75 degrees less than a fifth club (#5) and a club in a set having a lie angle of about 1.5 degrees less than the second alternating sequential adjacent club in a set in order to utilize lie values used in the market place. In view of the patent of Kajita it would have been obvious to modify the set of clubs of Teramoto to have at least 12 clubs in a set in order to have woods also to play a round of golf.

10. Claims 10-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto in view of Kilshaw.

Teramoto lacks a first golf club in a set having a head weight between 8-12 grams less than the second adjacent club in a set, a first club having a head weight of at least 8 grams less a second adjacent club in a set and a first club in a set having a head weight at least about 16 grams less than the second alternating sequential club in a set. Kilshaw discloses a first golf club (#3, Table 1, Invention) in a set having a head weight 8 grams less than the second adjacent club (#4, Table 1, Invention) in a set, and a first club (#3, Table 1, Invention) in a set having a head weight at least about 16 grams less than the second alternating sequential club (#5, Table 1, Invention) in a set. In view of the patent of Kilshaw it would have been obvious to modify the set of clubs of Teramoto to have a first golf club in a set having a head weight between 8-12 grams less than the second adjacent club in a set, a first club having a head weight of at least 8 grams less

a second adjacent club in a set and a first club in a set having a head weight at least about 16 grams less than the second alternating sequential club in a set in order to have a lighter lower numbered heads so a golfer can swing a lower numbered club at a higher speed.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto in view of Kajita as applied to claims 5-9, 18-19, and 22-23 above, and further in view of Kilshaw.

See paragraphs above for elements of structure previously rejected by Teramoto in view of Kilshaw

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto in view of Kajita as applied to claims 5-9, 18-19, and 22-23 above, and further in view of Ezaki.

Teramoto lacks a second club having a weight of at least about 9 grams less than a fifth golf club. Ezaki discloses heads in a set being 9-11 grams between adjacently sequenced clubs (4-5, 8-9, 9-10, 10-11) for shafts being different by .79 inches (Table). In view of the patent of Ezaki it would have been obvious to modify the set of clubs of Teramoto to have a second club having a weight of at least about 9 grams less than a fifth golf club in order to utilize a weight distribution which is used in the art for a set of club head.

Response to Arguments

13. The arguments with respect to how the previous examiner interpreted Kajita is agreed with. However the claims used different words to claim dimensions with some words allowing a broader limit as "a length at least about .6 inches" compared to "less than .6 inches". The examiner believes about .6 inches would include .59 inches.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 5 June 2004


STEPHEN BLAU
PRIMARY EXAMINER